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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,473	08/03/2001	Alex Urich	155696-0033	7208
1622	7590	11/15/2005		
IRELL & MANELLA LLP 840 NEWPORT CENTER DRIVE SUITE 400 NEWPORT BEACH, CA 92660			EXAMINER BOUCHELLE, LAURA A	
			ART UNIT 3763	PAPER NUMBER

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/922,473	Applicant(s) URICH, ALEX	
	Examiner Laura A. Bouchelle	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/82005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,16,18-22,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,16,18-22,24 and 25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 5, 16, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Saaski et al (US 5585011). Saaski discloses an input tube, a filter housing with filter, an input, and a flow restrictor wherein the input tube 40 has a diameter of about 1.52 mm (Col 14, lines 41-44) and the flow restrictor 42 has a diameter of about 0.5 mm (Col. 14, 46-47). This creates a non-linear relationship between pressure and flow rate (Col. 19, line 64 – Col. 20, line 11).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 5, 16, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley (US 699271) in view of Saaski et al. Easley discloses a device for preventing post occlusion flow surges during eye surgery comprising all of the limitations of the claims. Easley fails to explicitly disclose a flow restrictor with a diameter between 0.1 and 1.0 millimeters. Saaski teaches a flow restrictor having these dimensions as discussed above making it ideal for the purpose of maintaining proper flow

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restriction for delivery at low flow rates in humans and animals (Col. 14, lines 57-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Easley to be of the size specified by Saaski so that it can maintain proper flow restriction for delivery at low flow rates in humans and animals.

5. Claims 3, 4, 18, 19, 21, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley in view of Saaski et al as applied to claims 1, 5, 16, 20, and 22 above, and further in view of Beuchat (US 5267956). The claims differ from the teachings of Easley in view of Saaski in calling for luer fittings on the input and output tubing. Beuchat teaches luer type fittings for tubing because they make a fluid-tight junction between two fluid conduits (Col. 6, lines 13-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify device of Easley in view of Saaski to include luer fittings as taught by Beuchat to form a fluid-tight fitting junction between two conduits.

6. Claims 3, 4, 18, 19, 21, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saaski et al in view of Beuchat. The claims differ from Saaski in calling for luer fittings on the input and output tubing. Beuchat teaches luer type fittings for tubing because they make a fluid-tight junction between two fluid conduits (Col. 6, lines 13-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify device of Saaski to include luer fittings as taught by Beuchat to form a fluid-tight fitting junction between two conduits.

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Response to Arguments

7. Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive.

8. Applicant argues that the Saaski reference does not disclose a fluid regulator for dispensing medication. In response to applicant's arguments, that recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

9. Applicant further argues that the Saaski reference does not disclose the specific dimensional limitations of the claims. However, the examiner finds that the reference does contain those limitations as discussed in the above action.

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*,

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958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, features of Saaski are reasonably pertinent to the device of Easley in that it is a flow restrictor that limits the flow rate.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A. Bouchelle whose telephone number is 571-272-2125. The examiner can normally be reached on Monday-Friday 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 517-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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